



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,016	01/23/2001	Stanley B. Miller III	500	9290

7590 12/30/2002  
Joseph P. Gastel  
Suite 722  
295 Main Street  
Buffalo, NY 14203-2507

EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
----------	--------------

1615

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/768,016

Applicant(s)

MILLER ET AL.

Examiner

Susan Tran

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-7, 10-12 and 19-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7, 10-12, 19-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of applicant's Amendment filed 10/01/02.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-6, and 39-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Tuma et al. US 6,146,446.

Tuma teaches shaped adsorbent articles useful in electronic device (see abstract). The article comprising mixtures of adsorbent materials includes activated carbon, silica gel, calcium carbonate, potassium carbonate, potassium permanganate, calcium sulfate, and sodium carbonate; and binder includes microcrystalline cellulose, starch, sodium silicate, and polyvinylpyrrolidone (columns 5-6). The adsorbent article can be formed using compression molding or tablet-forming method (id, column 9, lines 47-62).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1615

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, and 39-48 rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al.

Tuma is relied upon for the reason stated above. Tuma does not teach first acid salt being primarily associated with the adsorbent, and second acid salt being primarily associated with the binder. However, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Absent of showing unexpected result, it is the position of the examiner that no criticality is seen in a particular second basic salt mixed with the binder. Hence, it would have been obvious for one of ordinary skill in the art to, by routine experimentation determine a suitable method with the expectation of at least similar result, because Tuma teaches adsorbent article for the same purpose desired by the applicant, e.g., adsorbent article used in electronic devices to adsorb acid gas.

Claims 7, 10-12, and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al., and Osborne et al. US 4,855,276.

Tuma is relied upon for the reasons stated above. Tuma is silent as to the limitation of second basic salt is associated with the binder, however, absent showing

Art Unit: 1615

evidence on the contrary, it is the position of the examiner that one of ordinary skill in the art would by routine experimentation determine a suitable process with the expectation of at least similar result, because Tuma teaches the use of adsorbent article containing the same material, same shape, and for the same purpose, absorbing acid gas to protect electronic devices from contaminants.

The reference is silent as to the teaching of sodium or potassium bicarbonate.

Osborne teaches adsorbent composition comprising activated carbon powder, activated alumina, water, and sodium bicarbonate (columns 5-6). Thus, it would have been prima facie obvious for one of ordinary skill in the art to prepare Tuma's adsorbent article using basic salts taught by Osborne, because the references teach the advantageous results in the use of basic salts in adsorbent composition. The expected result would be an adsorbent article in a variety of shapes useful to be placed in smaller spaces, such as disk drives.

### ***Response to Arguments***

Applicant's arguments filed 10/01/02 have been fully considered but they are not persuasive.

Applicant argues that Tuma does not teach the limitations of a "first basic salt being primarily associated with said adsorbent, and said second basic salt being primarily associated with said binder". However, it is the examiner's position that no criticality is seen in the particular limitations. There are no unusual and/or unexpected results, which would rebut prima facie obviousness since Tuma teaches an adsorbent

Art Unit: 1615

article useful for the same purpose, e.g., shaped adsorbent articles used in electronic devices for absorbing acid gas, filtering fluid and air (see abstract, columns 1 and 9).

Applicant argues that it would not have been obvious for one of ordinary skill in the art to modify Tuma's adsorbent article to produce the composition wherein a first basic salt being primarily associated with the adsorbent, and said second basic salt being primarily associated with the binder. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Tuma is silent as to the limitation of second basic salt is associated with the binder, however, absent showing evidence on the contrary, it is the position of the examiner that one of ordinary skill in the art would by routine experimentation obtain similar process with the expectation of at least similar result, because Tuma teaches the use of adsorbent article containing the same material, same shape, and for the same purpose, absorbing acid gas to protect electronic devices from contaminants.

While the generic claims claimed the particular limitation, dependent claims 4, 5, 10, 11, 29, 32, 35, 41, 42, 44, and 45 recited first and second basic salts can be selected from the same salt groups, such as sodium and potassium carbonates or

Art Unit: 1615

bicarbonates. Although there are dependent claims that recited first acid salt is selected from the carbonates salt group, and second acid salt is selected from the bicarbonates salt group, applicant's specification at page 5 disclosed potassium carbonate or any other suitable basic salt (first basic salt) may be used with the binder. Accordingly, no criticality is seen in the limitation of first basic salt is associated with the adsorbent, and second basic salt is associated with the binder.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Tran whose telephone number is (703) 306-5816. The examiner can normally be reached on Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

THURMAN K. PAGE  
SUPERVISOR  
TECHNICAL EXAMINER  
300